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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/611,918

07/03/2003

Takashi Igarashi

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OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

EXAMINER

SHAKERI, HADI

ART UNIT

PAPER NUMBER

3723

MAIL DATE

DELIVERY MODE

09/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/611,918

Applicant(s)

IGARASHI ET AL.

Examiner

Hadi Shakeri

Art Unit

3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/787,014.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 20070330; 20070509; 20070523.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application
- ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites for the table to include a turning speed of the tool defined in the specification, e.g., paragraph 169, as "cutter turning speed=tool turning speed"; the turning speed of the held lens, defined in the specification, e.g., paragraph 169, as "lens holding shaft turning speed=feed speed"; and a number of revolution of the lens defined in the specification, e.g., paragraph 164, as "=number of cutting (edging) turns" rendering the claim indefinite, since firstly the table as disclosed in Fig. 24 and described in paragraph 169 only lists the tool turning speed and the feed speed; and secondly the number of revolution of the lens (as best understood) would depend on the turning speed of the lens (feed speed) and the size/shape of the lens. The claim does not set forth the size and the shape of the lens. The limitation of setting the number of revolution of the lens is indefinite since the table and the description of the table as originally disclosed, does not support such disclosure, and further since this limitation is unclear. Rejection under 112 first paragraph is not applied at this time, since it appears for the deficiency to be of clarity rather than enablement. Applicant is requested to point out the support and clear the definition for this limitation.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 64-016346.

JP '346 meets all of the limitations of claim 5, i.e., a method of rough machining and finish machining (see Abstract) in which cutting speed

(revolution of lens as best understood), feed amount (feed speed), and a material (e.g., plastic as commonly used in the art) to be machined are inputted to an NC device for different type of machining (rough and finish machining disclosed) and a table comprising rows and columns would indicated the cutting speed and a feed rate of the tool for either or both rough and fine machining based on the inputted variables, except for explicitly disclosing groove engraving and

	T1	T2	T3	...
W1	V	V	V	...
W2	V	V	V	...
W3	V	V	V	...

	T1	T2	T3	T4	...
W1	V	V	V	V	...
W2	V	V	V	V	...
W3	V	V	V	V	...

chamfering, considered to be obvious modifications to one of ordinary skill in the art for adapting the method and the table to output values for grooving and chamfering. The table as disclosed includes a column for the type of the work, e.g., a material to be cut (see Abstract), but it does not appear to disclose the thickness of the lens, however, one of ordinary skill in the art would have known that desired finish and/or rough machining would directly depend on the thickness of the work, or the amount to be abraded, therefore it would have been obvious to one of ordinary skill in the art to modify the table to further include the thickness of work in addition to the material to be cut in achieving the desired results, e.g., in abrading a plastic lens commonly used.

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 64-016346 in view of Woods (5,053,971).

JP'346 as described above meets all of the limitations of claim 5, except for disclosing groove engraving and chamfering and the thickness of the lens. Woods teaches chamfering or beveling lens in which proper speed and feed rate are set based on the material selected (10:28) and thickness (04:45-55). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the invention of JP'346 with additional variables, e.g., thickness as taught by Woods to adapt the method for operations like chamfering, grooving, etc.

Response to Arguments

6. Applicant's arguments filed June 27, 2007 have been fully considered but they are not persuasive. The argument that JP'346 (Satoru) fails to disclose all the limitations recited, e.g., setting the variables based on the type of material, and the

Art Unit: 3723

thickness, is not persuasive, since as indicated above, the type of material is disclosed, and inputting the thickness would have been obvious to one of ordinary skill in the art, since the amount to be abraded would be among the first variables set by one of ordinary skill in the art. This argument is moot in view of the new rejection. It is further noted that rearranging the table as disclosed by JP' 346 to include other variables (known to one of ordinary skill in the art) or to be adapted for a particular application would be well within the knowledge of skilled artisan.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hadi Shakeri whose telephone number is 571-272-4495. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J. Hail, III can be reached on 571-272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 8, 2007

/Hadi Shakeri/
Primary Examiner, Art Unit 3723